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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Mary Balogh
Filed : June 27, 2003
For : SYSTEM FOR PROCESSING UNPAID HEALTHCARE
CLAIMS
Serial No. : 10/608,254
Priority Date : November 4, 2002

PETITION UNDER 37 C.F.R. 1.47(b)
INVENTOR REFUSES TO SIGN

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition the United States Patent and Trademark Office to accept the above-identified patent application without an executed Declaration from the sole inventor.

Please charge the required fee of one hundred thirty dollars (\$130.00), pursuant to 37 CFR 1.17(h), for filing this Petition to the Commissioner to Deposit Account 19-2179.

This Petition under 37 C.F.R. 1.47(b), is submitted by Siemens Medical Solutions Health Services Corporation (hereinafter, Petitioner) which owns a proprietary interest in the above-identified United States Patent Application and, after diligent effort, has been unable to obtain the signature of Ms. Mary Balogh (the sole Inventor for the above application). The Petitioner further requests that the United States Patent and Trademark Office accept the above-identified patent application without an executed Declaration from the sole Inventor, Ms. Mary Balogh, as after diligent efforts as outlined below, Petitioner has been unable to obtain the signature of Ms. Mary Balogh on the Declaration form.

A response to the Notice of Missing Parts of Nonprovisional Application filed under 37 CFR 1.53(b) dated September 23, 2003 along with a request for a two-month extension, ending January 23, 2004 is being filed with this petition. Exhibits are also submitted with this petition in support of Petitioner's claim that the Inventor refuses to sign the Declaration.

Petitioner submits that, in view of the request for two month extension of time and the attached Certificate of Mailing, this Petition is timely.

The last known address for Ms. Mary Balogh is:

6301 Grant Street
Hollywood, FL 33024

In support of this petition, Applicants have attached a letter prepared by Ms. Ann Strong, Counsel for Petitioner and sent via Federal Express Tracking No. 638249986739 to Mary Balogh dated October 10, 2003. Accompanying this letter were the subject U.S. Patent Application, a Declaration to be executed by the Inventor and an Assignment also to be executed by the Inventor. A copy of this letter, as well as a copy of the unsigned Declaration and the Assignment are submitted herewith as Exhibit A.

The letter, U.S. Patent Application, Declaration and Assignment were shipped via Federal Express Tracking No. 638249986739 to Mary Balogh at the above listed address by Mr. Dean Miller, an employee of Petitioner on October 15, 2003. The above documents were delivered to and received by Mary Balogh on October 17, 2003 as evidenced by the Federal Express Tracking Record delivery information attached herewith as Exhibit B. This tracking record clearly shows that M. Balogh signed for and was in possession of the above documents as of October 17, 2003.

As required by 37 C.F.R. 1.47(b) and MPEP section 409.03(b)(C) Exhibits A and B are submitted as proof that diligent effort was made to present original copies of the above U.S. Patent Application, the Declaration and the Assignment to Mary Balogh to be executed thereby and that these documents were received by Mary Balogh.

Thereafter, it was determined that Mary Balogh refused to sign the Declaration and Assignment as evidenced by the series of emails submitted herewith as Exhibit C. The details of the emails are as follows (read from the last page forward):

On January 7, 2004, Alex Burke, Intellectual Property Counsel of Petitioner sent an email to both Mary Balogh and Robert Haskell, Supervisor to Mary Balogh during her employment with Petitioner, asking Mr. Haskell to notify Ms. Balogh as to the amount of financial compensation she is entitled upon issue of the above U.S. Patent Application.

On January 7, 2004, Mr. Haskell replied to Mr. Burke with a copy sent to Mary Balogh stating that Ms. Balogh would receive \$1000.00 as part of her inventor award.

Ms. Balogh responded to this email on January 7, 2004 that the above discussed financial award "won't even cover my shoe budget for the summer."

On January 8, 2004, Alex Burke sent another email to Ms. Balogh asking if Ms. Balogh was going to execute the Declaration and Assignment, and if so, when Mr. Burke would receive said executed Declaration and Assignment.

Ms. Balogh replied to Mr. Burke on January 8, 2004 stating "I am not" thereby indicating she refused to sign the Declaration and Assignment.

These emails are provided herewith as Exhibit C to show that the sole Inventor, Ms. Mary Balogh, refused to sign the Declaration and Assignment associated with the above U.S. Patent Application.

In order to show the Applicants proprietary interest in the above-identified invention, a copy of an Employment Agreement signed by Ms. Mary Balogh on December 3, 2001 is attached as Exhibit D. A Provisional United States Patent Application Serial No. 60/423,471 from which the subject application claims the benefit of was filed in the United States Patent and Trademark Office on November 4, 2002. This date is during the period of employment of Ms. Balogh with the Petitioner. According to section 7.0 of the Employment Agreement entitled, Ownership of Work Product, "All 'work'....shall be considered 'work made for hire'...and that Siemens is and shall be the sole owner of all rights therein". Thus, as the invention described in the subject patent application was conceived during the term of employment of Mary Balogh with Petitioner, it is respectfully submitted that the Petitioner has a proprietary interest in the subject United States Patent Application and granting of this petition is necessary in order to preserve the rights of the Petitioner.


I, Alexander J. Burke, I.P. Counsel for Petitioner, am authorized to submit this Petition on behalf of Petitioner.

In view of the above remarks and attached exhibits, it is thus respectfully submitted that this petition complies fully with the requirements of 37 CFR 1.47(b) by including:

- a) payment of the petition fee under 37 C.F.R. 1.17(i);
- b) a statement of the last known address of Ms. Balogh, the sole inventor refusing to sign the Declaration and Assignment;
- c) evidence of diligent efforts to reach Ms. Balogh;
- d) evidence of Ms. Balogh's refusal to sign both the Declaration and Assignment; and
- e) Petitioner's demonstrated proprietary interest in the above U.S. Patent Application.

No additional fee is believed due. However, if an additional fee is due, please charge the fee to Deposit Account 19-2179.

Respectfully submitted,

By: 
Alexander J. Burke
Reg. No. 40, 425

Siemens Corporation
Intellectual Property Dept.
180 Wood Ave. South
Iselin, NJ 08830
Tel: (732) 321 – 3023
Fax: (732) 321 – 3030

Dated: January 19, 2004

EXHIBIT A

SIEMENS

October 10, 2003

VIA FEDERAL EXPRESS

Mary Balogh
6301 Grant Street
Hollywood, FL 33024

Re: Patent application

Dear Mary:

Please find enclosed the U.S. Patent Application "System for Processing Unpaid Healthcare Claims" that relates to an Invention Disclosure that you provided to us while you were an employee. These original documents require your signature as well as notarization before they can be filed in the U.S. Patent and Trademark Office.

We request that you please execute the documents in front of a notary, have them notarized, and return them to us using the enclosed pre-paid Federal Express envelope. We have enclosed \$20.00 to cover the cost of the notary and for copying charges for your copy of the executed documents. Alternatively, feel free to ask us to return a copy to you when you send the documents back.

Mary, we are sorry to put you to the inconvenience of having to go to a notary and thank you for your help in closing out this matter. If you have any questions regarding these documents please feel free to call me at 610-219-4661.

Sincerely yours,



Ann Strong
Counsel

Enclosures

Siemens Medical Solutions Health Services Corporation

51 Valley Stream Parkway
Malvern, PA 19355-1406

Tel: 610-219-6300
Fax: 610-219-3124
www.smed.com

EXHIBIT B



FedEx Express
Customer Support Trace
3875 Airways Boulevard
Module H, 4th Floor
Memphis, TN 38116

U.S. Mail: PO Box 727
Memphis, TN 38194-4643

Telephone: 901-369-3600

1/9/2004

Dear Customer:

Here is the proof of delivery for the shipment with tracking number **638249986739**. Our records reflect the following information.

Delivery Information:

Signed For By: M. BALOGH



Delivery Location: 6301 GRANT STREET

Delivery Date: October 17, 2003

Delivery Time: 1257

Shipping Information:

Tracking N : 638249986739

Ship Date: October 15, 2003

Recipient:

MARY RALOGH
6301 GRANT STREET
HOLLYWOOD, FL 33024
US

Shipper:

DEAN MILLER
SIEMENS HEALTH SERVICES
51 VALLEY STREAM PKWY
MALVERN, PA 19355
US

Shipment Reference Information:

65300CHARLESWORTH/93817

Thank you for choosing FedEx Express. We look forward to working with you in the future.

FedEx Worldwide Customer Service
1-800-Go-FedEx®
Reference No.: R2004010900107451482

EXHIBIT C

BRISCOE CHRISTINE

From: BURKE ALEXANDER
Sent: Thursday, January 08, 2004 11:25 AM
To: BRISCOE CHRISTINE
Subject: FW: 02P18305US01 - Mary Balogh

-----Original Message-----

From: Balogh, Mary [mailto:Mary.Balogh@holy-cross.com]
Sent: Thursday, January 08, 2004 11:25 AM
To: BURKE ALEXANDER
Subject: RE: 02P18305US01 - Mary Balogh

Alex,

I am not. I am not in need of this particular thousand dollars. I know what this means for you, and for that I apologize. I wonder how much the next efforts will end up costing the company. I think it is a safe guess that it will be more than one thousand.

Best regards,

Mary

-----Original Message-----

From: BURKE ALEXANDER [mailto:Alexander.Burke@siemens.com]
Sent: Thursday, January 08, 2004 10:39 AM
To: Balogh, Mary
Subject: RE: 02P18305US01 - Mary Balogh
Importance: High

Mary,

Could you please let me know whether or not you are going to execute the declaration and assignment for the subject application and if you are, when I can expect to receive it?

Best regards,
Alex

Alexander J. Burke Esq.,
Intellectual Property Counsel - Siemens Corporation Intellectual Property Dept. 170 Wood Avenue South Iselin NJ 08830 USA Tel 732 321 3023 Fax 732 321 3030 Email alexander.burke@siemens.com
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-----Original Message-----

From: Balogh, Mary [mailto:Mary.Balogh@holy-cross.com]
Sent: Wednesday, January 07, 2004 5:08 PM
To: BURKE ALEXANDER
Subject: RE: 02P18305US01 - Mary Balogh

That won't even cover my shoe budget for the summer.

Thanks,

Mary

-----Original Message-----

From: Haskell Robert [mailto:robert.haskell@siemens.com]

Sent: Wednesday, January 07, 2004 4:55 PM

To: 'BURKE ALEXANDER'

Cc: Balogh, Mary

Subject: RE: 02P18305US01 - Mary Balogh

Alex,

Upon issue of the subject patent application, Mary will receive \$1,000.

Regards,

Bob

-----Original Message-----

From: BURKE ALEXANDER [mailto:Alexander.Burke@siemens.com]

Sent: Wednesday, January 07, 2004 4:21 PM

To: Haskell Robert

Cc: 'mary.balogh@holy-cross.com'

Subject: 02P18305US01 - Mary Balogh

Importance: High

Bob,

Could you please let both myself and Mary know how much she will receive as final portion of her inventor award upon issue of the subject patent application. Best regards,

Alex

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reply e-mail and destroy all copies of the original.

EXHIBIT D

EMPLOYMENT AGREEMENT

EMPLOYMENT AGREEMENT made between Siemens Medical Solutions Health Services Corporation ("Siemens" or "Company"), having its principal office at Malvern, PA, and Mary Balogh an individual residing at 6301 Grant Street Hollywood, FL 33024 ("Employee"). Employee and Siemens agree as follows:

1.0 EMPLOYMENT, COMPENSATION AND BENEFITS.

- 1.1 Siemens hereby provides to Employee employment, compensation and benefits as described herein and Employee hereby accepts such employment, compensation and benefits, upon the terms and conditions hereinafter set forth.
- 1.2 Employee shall perform such duties as may be assigned from time to time by Siemens, shall devote full attention and energies to the business of Siemens, and shall faithfully perform her duties in accordance with the direction of her Siemens manager. Employee agrees to adhere to all Siemens policies as outlined in the Employee and Benefits Guides.
- 1.3 Employee shall be entitled to participate in all Siemens benefits plans including group life insurance, medical, and other benefits such as annual vacation, holidays and sick leave as set forth in the Siemens Employee and Benefits Guides and in accordance with the terms and conditions of such plans. This Agreement does not alter Employee's rights, if any, to her accrued benefits under Siemens benefit plans.

2.0 DEFINITIONS. For Purposes of this Agreement, the following definitions shall apply:

- 2.1 **"Severance Pay"** is a benefit paid in the regular payroll cycle (except where specifically stated otherwise) and has two components (i) Base Compensation, and (ii) the cost of the Employee's medical premium to continue Employee's current level of medical and dental coverage pursuant to COBRA. Severance will be paid only if Employee (i) executes a general release of all claims against the Company, (ii) has adhered and continues to adhere to the post-employment obligations under Sections 4.0 and 5.0. Severance Pay is provided under Siemens' normal payroll cycle and process.
- 2.2 **"Base Compensation"** is Employee's monthly salary.
- 2.3 **"Cause"** shall mean Employee's (i) dishonest or illegal conduct, (ii) breach of her obligations under this Agreement, (iii) conduct contrary to the best interests of Siemens, (iv) insubordination, incompetence, misconduct, poor performance or neglect of her duties, or (v) willful violation of any lawful direction of management.
- 2.4 **"Variable Pay"** shall mean additional compensation that Employee may be eligible for under the terms and conditions of the Company's Variable Pay plans.

3.0 SEVERANCE PAY.

- 3.1 Notwithstanding any provision in this Agreement, the Company retains its right to terminate Employee's employment with or without Cause. Upon termination without Cause, Employee shall be entitled to receive Severance Pay for the period of time beginning after Employee's termination date and for one week per year of service thereafter so long as all of the conditions for Severance Pay outlined above are met. These payments shall be Employee's sole severance benefit in the event of Employee's termination without Cause.
- 3.2 In the event of termination for Cause, Siemens shall not be obligated to make any payments other than the payment of earned or accrued, but unpaid, salary and benefits.
- 3.3 If Employee is unable to perform her duties and responsibilities by reason of a disability as defined under Company's short-term disability plan, Company shall provide to Employee, for a period of 6 months, a short-term disability benefit equal to 60% of Base Compensation. This short-term disability benefit shall be capped at \$10,000 per month and reduced by the amount of payments due Employee for this time period under any applicable disability benefit programs, including Social Security disability, workers' compensation and disability retirement benefits.
- 3.4 In the event that Employee dies during the term of this Agreement, Siemens shall pay to her executors or administrators, as appropriate, for a period of 3 months, Employee's Base Compensation. To the extent possible, such payments will be non-taxable death benefits under the Internal Revenue Code.

4.0 CONFIDENTIAL INFORMATION.

- 4.1 In entering this Agreement, Employee represents and warrants that she has not signed any non-compete or confidentiality agreement that will be violated by entering into this Agreement. Employee acknowledges that she has not, and will not, in connection with employment by Siemens, divulge any confidential information, trade secrets, or copyright-protected information of any prior employer, except as agreed to be such prior employer.
- 4.2 Siemens will provide to Employee or Employee will learn, trade secrets and other confidential information of Siemens and third parties. Examples of this information include computer programs, marketing and development plans, proprietary product and service offerings data about Siemens, customer and prospect lists and requirements, employee lists, salaries and benefits, financial information and customer and vendor data. During Employee's employment and at all times afterward, Employee shall keep confidential all such information and material and will not disclose such information to any person or entity or make any use of this information, except as required in the performance of Employee's employment responsibilities at Siemens or as required by law. When Employee leaves Siemens' employment, Employee will immediately return to Siemens all materials containing such information. Such materials shall, at all times, be the property of the Company.

5.0 NON-COMPETITION.

5.1 During the term of this Agreement and for 12 months following the termination of Employee's employment, Employee will not, without Siemens' prior written consent : (i) compete with Siemens' business activities or accept employment with a competitor of Siemens, (ii) solicit any customer or potential customer of Siemens that Employee or her subordinates solicited or serviced for Siemens, or (iii) solicit to leave Siemens or hire any individual who was an Siemens employee during Employee's employment at Siemens.

5.2 If Employee is unable to secure employment due solely to the restrictions in 5.1 and (i) Employee has requested in writing to be released by Siemens from the non-compete in 5.1 and (ii) Siemens has denied the request, and has been unwilling to modify the restrictions in 5.1 to enable Employee to accept a position with a competitor, Siemens will provide Severance Pay to Employee, provided such Employee is not receiving Severance Pay under Section 3 of this Agreement. Under this Section 5.2, Siemens will continue to provide Severance Pay until the earliest of the following: (i) the expiration of the non-compete period; (ii) Siemens provides a written release from the non-compete obligation under 5.1 or modifies the restrictions in 5.1 so as to allow employment with a competitor; or (iii) the Employee becomes otherwise employed.

To continue to receive Severance Pay under this provision, Employee must make reasonable efforts to secure employment which would not violate her non-compete obligation. Upon request from Siemens, Employee will provide to Siemens a description of her job search efforts. Siemens shall, at Siemens' option, be relieved from making a monthly payment to Employee under this provision if the Employee is not making reasonable efforts to secure employment or Siemens has provided written permission to accept available employment.

5.3 Employee acknowledges that the limitation as to time and the limitation on the character or nature placed on her subsequent employment are reasonable and fair and will not prevent or materially impair her ability to earn a livelihood.

5.4 Should Siemens release Employee under Section 5.2, during the term of this Agreement and for 12 months thereafter, Employee will not accept any bonus, stock options or any other form of compensation based on the overall performance of a competitor, or a division that competes with Siemens.

6.0 BREACH OF SECTIONS 4.0 AND/OR 5.0.

6.1 Employee acknowledges that a breach of Sections 4.0 and/or 5.0 would threaten Siemens with irreparable harm and that Siemens would be entitled to injunctive relief against the breach or threatened breach of Employee's obligations under these Sections, in addition to any other legal remedies which may be available.

6.2 In addition to all remedies available to Siemens at law or in equity for Employee's violation of Sections 4.0 and/or 5.0, Siemens and Employee agree that, should Employee violate her obligations under Sections 4.0 and/or 5.0 then Employee shall pay to Company all Severance Pay which had been provided to Employee.

- 6.3 Payment by Employee to the Company must be made within 30 days after Employee's breach; additionally, Siemens shall have the right to deduct amounts owed by Employee to Company hereunder from any amounts owed by Company to Employee, and Employee shall continue to be liable to Company for amounts to the extent they are not fully recovered by Company by means of such set-off.

7.0 OWNERSHIP OF WORK PRODUCT.

The parties agree that all "Work" (which shall include for purposes of this Section all ideas, processes, methodologies, software, algorithms, formulae, notes, outlines, photographs, inventions, improvements, and other information and work product developed or generated by or on behalf of Siemens during the course of the Employee's performance under this Agreement and for six months thereafter), shall be considered "works made for hire" within the meaning of the Copyright Act of 1976, 17 U.S.C. §101 et seq., and that Siemens is and shall be the sole owner of all rights therein, including but not limited to all rights of copyright. In the event any of the Work is deemed not to be a "work made for hire," then Employee hereby transfers to Siemens, without further consideration, all right, title, and interest to such Work, including any and all patents, copyrights, trade secrets and other proprietary rights related thereto. Employee agrees to promptly execute and deliver, or cause to be promptly executed and delivered, all documents and instruments requested by Siemens to evidence the foregoing assignment.

8.0 MISCELLANEOUS.

This Agreement (i) may not be amended except in a writing executed by both parties, (ii) shall only be governed by and construed in accordance with the laws of the Commonwealth of Pennsylvania, (iii) shall be litigated only in the Court of Common Pleas of Chester County, Pennsylvania, or the United States District Court for the Eastern District of Pennsylvania, (iv) shall be binding upon and inure to the benefit of Siemens and Employee and their respective successors and permitted assigns and the Company will require its successors to expressly assume its obligations under this Agreement, and (v) represents the entire Agreement and understanding of the parties with respect to the subject matter hereof and supersedes all prior agreements and understandings of the parties in connection therewith. If any portion of this Agreement is deemed to be unenforceable, the balance of this Agreement shall nevertheless continue in effect and any court may enforce any provision to the extent permitted by law, even though the entire provision may not be enforced. This Agreement shall not be assignable by Employee.

The undersigned, intending to be legally bound, have duly executed this Agreement as of the date written below.

ACCEPTED:

ON BEHALF OF SIEMENS MEDICAL
SOLUTIONS HEALTH SERVICES

M. Balogh

Mary Balogh

By: Mary Appeler 12/7/2001
Human Resources Representative

12-3-01

DATE

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

January 19, 2004

Date



Alexander J. Burke

Reg. No. 40, 425

(732) 321-3023

Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Mary Balogh

State of)
): ss
County of)

Before me this _____ day of _____, 2003 personally appeared Mary Balogh to me personally known to be the person who is described in and who executed the above instrument, and acknowledged to me that he executed the same of his own free will for the purpose therein set forth.

[Seal]

Notary Public